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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,070	03/30/2004	Steven A. Kulchin	KULS122520	8898
26389	7590	11/02/2004	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			LEE, JONG SUK	
		ART UNIT		PAPER NUMBER
				3673

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/816,070	KULCHIN, STEVEN A. 
Examiner	Art Unit	
Jong-Suk (James) Lee	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-5 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-5 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/29/2004.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claim 4 is objected to because of the following informalities:

Claim 4, line 2: "said retaining wall" should be --said temporary retaining wall--.

Claim 4, line 11: "said retaining wall" should be --said temporary retaining wall--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peirce, Jr. et al. (US 4,911,582) in view of Calandra, Jr. et al. (US 5,314,268).

Peirce, Jr. et al discloses a concrete replacement wall and method of constructing the wall comprising of: a temporary retaining wall (11) for a soil excavation being provided by boring holes in a side wall of the soil excavation, soil nails (42) (see Fig. 4) extending outwardly into the soil side wall from the temporary retaining wall (11) with inserting a reinforcing rod into the hole and filling the holes with cementitious filler material (see col.2, lines 6-11), the filler

material being affixed to the temporary retaining wall by tying the reinforcing rods to the temporary retaining wall, and a separate, permanent, lateral load bearing wall (12) being formed inwardly of the temporary retaining wall (see Figs. 1-6; col.4, lines 62-68; col.5, lines 1-68; col.6, lines 1-68; col.7, lines 1-6).

However, Peirce, Jr. et al fails to disclose or fairly suggest the rod of the soil nail comprising an easily shearable reinforcing rod which is made of a fiber reinforce polymer. Calandra, Jr. et al discloses a non-metallic reinforcing rod (52) comprising of an elongated rod of polymeric material (see col.5, lines 37-66), the reinforcing rod being embedded into the hole and affixed with cementitious filler material/resin (72) for use in anchoring the roof plate and supporting rock formation (see Figs. 1-10; col.2, lines 12-22; col.6, lines 62-68; col.7, lines 1-61).

Therefore, in view of Calandra, Jr. et al, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to replace the rod portion of the soil nail with the polymeric rod in order to use the area where requires the lesser tensile strength criteria and further to be easily breakable while the excavating machine being used to the reinforced area.

#### ***Obviousness-Type Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent No. 6,796,745. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somewhat broader recitation of the '745 Patent, for example, in claim 4 of present claimed invention and claim 1 of the '745 Patent, the Applicants claim:

“.....boring holes in the sidewall of said soil excavation that extend into the adjoining property; inserting easily shearable reinforcing rods into said holes, said rods extending into said adjoining property; forming a temporary retaining wall adjacent the sidewall of said excavation; filling said holes with and forming a temporary retaining wall from cementitious material; tying said rods to said retaining wall; and forming a separate, permanent, lateral load-bearing wall inwardly of said temporary retaining wall”.

Whereas in the '745 Patent, the Applicants claim “.....boring holes in the sidewall of said soil excavation; inserting easily shearable reinforcing rods into said holes; forming a temporary retaining wall adjacent the sidewall of said excavation; filling said holes with and forming a temporary retaining wall from cementitious material; tying said rods to said retaining

wall; forming a separate, permanent, lateral load-bearing wall inwardly of said temporary retaining wall; and thereafter, excavating said adjoining property by shearing said rods and surrounding cementitious material as said adjoining property is excavated”.

Therefore, in respect to above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of claim 1 of the '745 Patent as a general teachings for a method for making a temporary retaining wall for a soil excavation with using the easily sharable reinforcing rods. Further, with respect to the added limitation, “(hole)...that extend into the adjoining property...., said rods extending into said adjoining property” in claim 4, lines 4-7 of the present application, it is understood to be an obvious matter of the retaining wall design because the reinforcing rods/anchor/nail are extended into the adjoining property/soil formation in order to accomplish the desired purpose of soil reinforcement.

The instant claims obviously encompass the claimed invention of '745 Patent . To the extent that the instant claims are broaden and therefore generic to the claimed invention of '745 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

6. The obviousness-Type double patenting rejection is based on a judicially created doctrine grounded in public policy is primarily intended to prevent the prolongation of the patent term by

prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application of patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130 (b).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other references cited disclose a soil nail apparatus, a corrosion protected earth tieback and an injection cable bolt.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The examiner can normally be reached on 6:30 am to 3:00 pm, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, , Heather C. Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Lee /jtl  
October 29, 2004



**Jong-Suk (James) Lee  
Primary Examiner  
Art Unit 3673**